

■ Managing an International Registration

Seminar on the Hague System for the International Registration of Industrial Designs

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Examiner
Operations service
The Hague Registry

**Geneva
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Types of Changes

01 Renewal
Prolonging protection

02 Renunciation;
Limitation
Reduce protection scope

03 Change in Ownership
Transfer rights

04 Holder's name/address;
Representative
Update Info.

Major advantages

One request

One language
(English, French, Spanish)

One office
(International Bureau)

One payment
(one set of fees)

One currency
(Swiss francs)

■ RENEWAL

Article 17 of the 1999 Act

Article 11 of the 1960 Act

Rules 23-25 of the Common Regulations

Renewal

■ Duration of Protection

- Initial term: five years

- Minimum duration

 - 1960 Act: 10 years (5 + 5)

 - 1999 Act: 15 years (5 + 5 + 5)

- maximum duration in each CPs:

 - (see declarations of CPs:

 - <http://www.wipo.int/hague/en/declarations/declarations.html>)

Present Renewal Request

- **Paper form:** DM/4

- **E-renewal:**

https://webaccess.wipo.int/erenewal_dm/IndexController?lang=EN

- Launched in December 2010

- Easy to use

- Automatically calculate the renewal fees

- Online payment (current account or credit card)

Procedure for Renewal

- **Unofficial expiry notice** (6 months before)
- **Contents of the request**
 - international registration number
 - name and address of the holder
 - scope of renewal
 - signature
 - payment of fees
- **Grace period:** within six months after the expiry date (additional surcharge)

Scope of Renewal

- **Total renewal**

- **Partial renewal**

- for SOME of the designated CPs only

- for SOME of the designs only

Designated CPs	Design 1	Design 2	Design 3
CH	✓	✓	✓
EM	✓	✓	✓
TR	✓	✓	✓

Scope of Renewal

- **Total renewal**
- **Partial renewal**
 - for SOME of the designated CPs only
 - for SOME of the designs only
- **E-renewal:** « tailor-made » renewal

Designated CPs	Design 1	Design 2	Design 3
CH	✓		✓
EM		✓	
TR		✓	✓

Conditions for Renewal

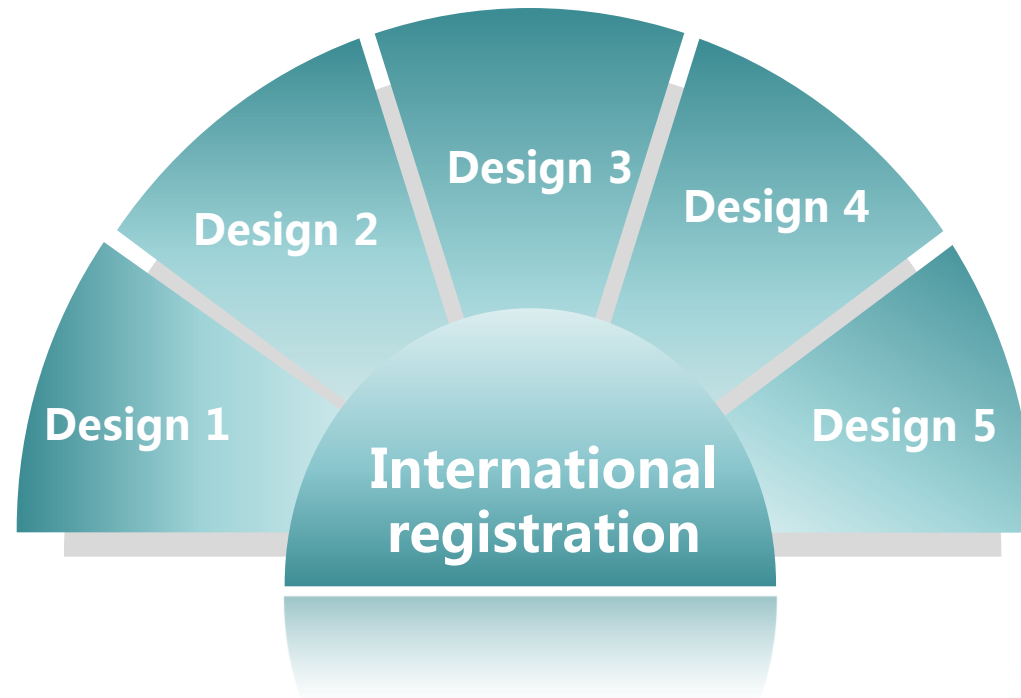
Possible

- maximum period expired
- refusal recorded

NOT Possible

- renunciation recorded
- limitation recorded
- invalidation recorded

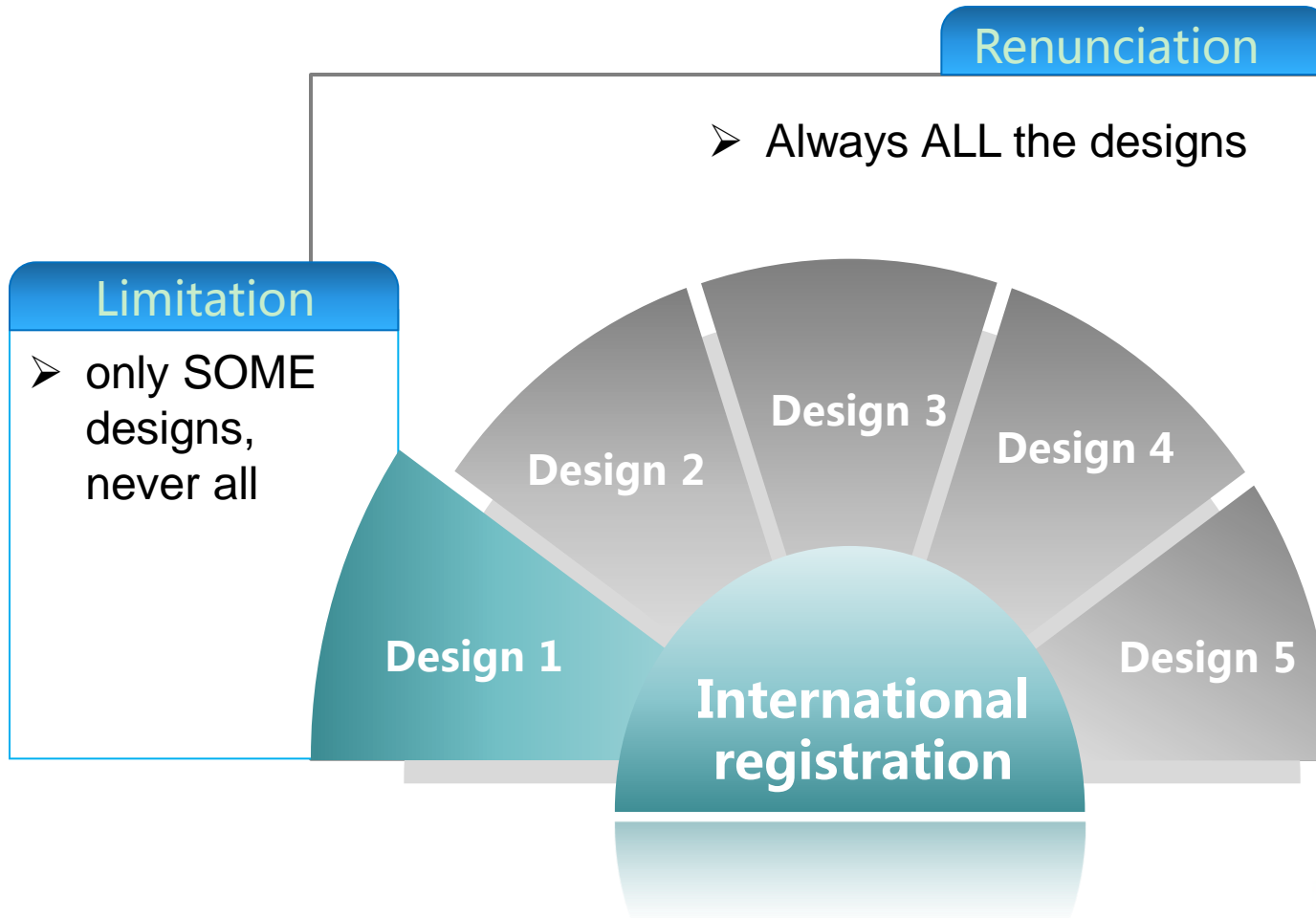
Renunciation and Limitation



Renunciation and Limitation



Renunciation and Limitation



■ RENUNCIATION

Article 16(1)(iv) of the 1999 Act

Article 13 of the 1960 Act

Rule 21 of the Common Regulations

Renunciation

- Always concerns **ALL** designs
- May relate to **SOME** or **ALL** designated CPs
- **Request form: DM/5** (mandatory)
 - international registration number
 - name of the holder recorded
 - concerned designated CP(s)
 - signature
 - payment of fees

Renunciation

- Total renunciation:
 - ALL designated CPs

Designated CPs	Design 1	Design 2	Design 3
CH	✓	✓	✓
EM	✓	✓	✓
TR	✓	✓	✓

Renunciation

- Total renunciation:
 - ALL designated CPs
- Partial renunciation:
 - SOME designated CPs

Designated CPs	Design 1	Design 2	Design 3
CH	✓	✓	✓
EM	✓	✓	✓
TR	✓	✓	✓

■ LIMITATION

Article 16(1)(v) of the 1999 Act
Rule 21 of the Common Regulations

Limitation

- **Request form: DM/3 (mandatory)**
- Only concerns **SOME** of the designs, **NEVER ALL**
 - **ALL** designated CPs
 - **SOME** of the designated CPs

Designated CPs	Design 1	Design 2	Design 3
CH	✓	✓	✓
EM	✓	✓	✓
TR	✓	✓	✓

■ CHANGE IN OWNERSHIP

Article 16(1)(i) and (2) of the 1999 Act

Article 12 of the 1960 Act

Rules 21-21*bis* of the Common Regulations

Present the Request

- **Request form:** DM/2 (mandatory)
- **Who can present the request?**
 - presented and signed by the holder;
 - presented by the *new owner*, provided that:
 - signed by the holder, or
 - signed by the **new owner** + **attestation** from competent authority of the holder's CP that the new owner appears to be the successor in title of the holder

Contents of the Request

- Contents of the request:
 - international registration number
 - name of the holder recorded
 - name and address of the *new* owner
 - entitlement of the *new* owner
 - scope of change
 - must be signed by the holder
 - payment of fees

Entitlement of the new owner

- The *new* owner must be **entitled** to file an international application
 - Nationality
 - Domicile
 - Real and effective industrial or commercial establishment
 - Habitual residence (the 1999 Act only)

- There must be a **common treaty** between the *new* owner's CP(s) and each designated CP

Example 1

■ Can the new owner be recorded as the new holder?

Current holder



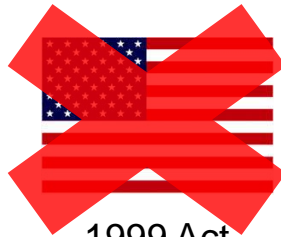
1960 Act

a member of EU



1999 Act

Designated CPs



1999 Act



1960/1999 Acts



1999 Act



1960 Act

New owner



1960 Act

Example 1

■ Result of change in ownership

Previous holder



1960 Act

New holder



1960 Act

Designated Countries



1999 Act



1999 Act

Designated Countries



1960/1999 Acts



1960 Act

Example 2

■ Can the new owner be recorded as the new holder?

Current holder



1960 Act

a member of EU



1999 Act

Designated CPs



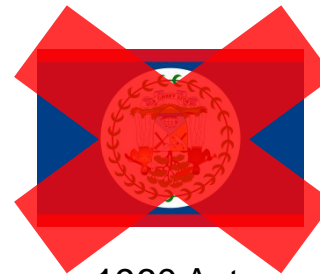
1999 Act



1960/1999 Acts



1999 Act



1960 Act

New owner



1999 Act

Example 2

■ Result of change in ownership

Previous holder



1960 Act

New holder



1999 Act

Designated Countries



1960 Act

Designated Countries



1999 Act



1960/1999 Acts



1999 Act



Scope of Change in Ownership

■ Total change

■ Partial change

- for SOME of the designated CPs only
- for SOME of the designs only

Designated CPs	Design 1	Design 2	Design 3
CH	✓	✓	✓
EM	✓	✓	✓
TR	✓	✓	✓

Scope of Change in Ownership

■ Total change

■ Partial change

- for SOME of the designated CPs only
- for SOME of the designs only
- « tailor-made » change

Designated CPs	Design 1	Design 2	Design 3
CH		✓	
EM		✓	
TR			

DM/2 Item 6 - Scope

6 SCOPE OF THE CHANGE IN OWNERSHIP (check either (a) or (b))

(a) **TOTAL CHANGE IN OWNERSHIP** the change in ownership is to be recorded for **all** the Contracting Parties designated in the international registration(s) indicated in item 1, and for **all** the industrial designs included in such international registration(s);

(b) **PARTIAL CHANGE IN OWNERSHIP**

(i) the change in ownership is to be recorded for the designated Contracting Parties indicated below (if no Contracting Party is indicated, it will be understood that the change in ownership is to be recorded in respect of all the designated Contracting Parties), and/or

.....
.....
.....
.....

(ii) the change in ownership is to be recorded for the designs indicated below (indicate only the number of the designs); if no designs are indicated, it will be understood that the change in ownership is to be recorded in respect of all designs:

.....
.....
.....
.....



DM/2 Item 8 - Signature

8

SIGNATURE AND/OR SEAL (read note 1 on cover page)

(a) Identify the signatory by checking the appropriate box:

- | | |
|---|--------------------------|
| (i) Holder (transferor) | <input type="checkbox"/> |
| (ii) Representative of the holder (transferor) | <input type="checkbox"/> |
| (iii) New owner (transferee) | <input type="checkbox"/> |
| (iv) Representative of the new owner (transferee) | <input type="checkbox"/> |

(b) Name:

(c) Signature and/or seal:

(d) Date of signature (dd/mm/yyyy):

Name of the person to contact, if necessary:


DM/2 Item 8 – Signature NOT Accepted

8 SIGNATURE AND/OR SEAL
(read note 1 on cover page)

(a) Identify the signatory by checking the appropriate box:

- (i) Holder (transferor)
- (ii) Representative of the holder (transferor)
- (iii) New owner (transferee)
- (iv) Representative of the new owner (transferee)

(b) Name: Johannes SEIRINGER

(c) Signature and/or seal: 

(d) Date of signature (dd/mm/yyyy):

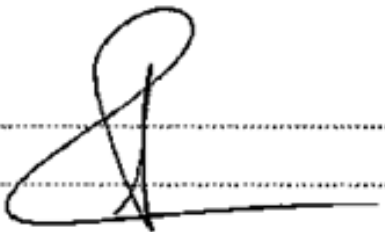
Name of the person to contact, if necessary:

8 SIGNATURE ET/OU SCEAU
(voir la note 1 sur la page de couverture)

a) Qualité du signataire (cocher la case qui convient) :

- i) Titulaire (le cédant)
- ii) Mandataire du titulaire (le cédant)
- iii) Nouveau propriétaire (le cessionnaire)
- iv) Mandataire du nouveau propriétaire (le cessionnaire)

b) Nom : Cabinet GERMAIN & MAUREAU

c) Signature et/ou sceau : 

d) Date de la signature (jj/mm/aaaa) : 07/02/15

Nom de la personne à contacter, si nécessaire : Nicolas PELESE

Change in Ownership has **NO** Effect

■ **Article 16(2) of the 1999 Act**

- has NO effect in a CP until the Office received the statements or documents specified in the declaration

➤ *OAPI, DK, KR, US*

- recording of a partial change in ownership is NOT allowed

■ **Rule 21bis Declaration**

- Declaration must be sent to the IB within 6 months
- IB records the Declaration and modify the IR
- IR concerned shall remain in the name of the transferor
- IB notifies transferor and transferee

■ CHANGE IN NAME AND/OR ADDRESS OF THE HOLDER

Article 16(1)(ii) of the 1999 Act
Rules 21 of the Common Regulations

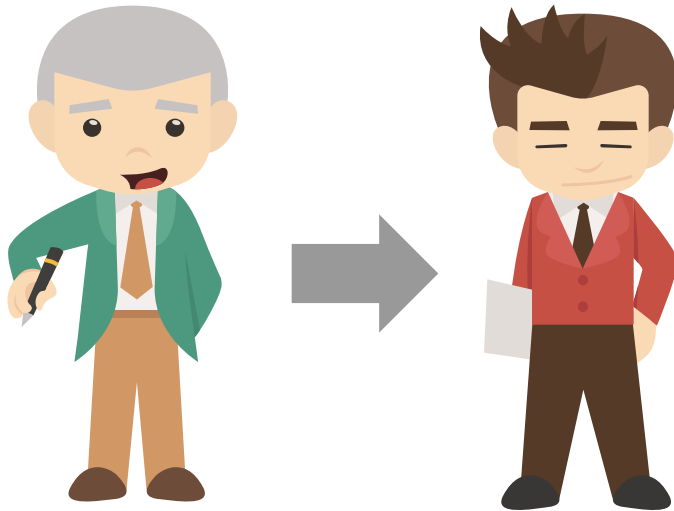
Procedure

- **Request form: DM/6 (mandatory)**
 - international registration number
 - name of the holder recorded
 - the change in name and/or address of the holder
 - signature
 - payment of fees

Change in Ownership & Change in Name

Change in Ownership

From A to B



Change in Name of holder

the SAME holder



■ APPOINTMENT, CHANGE OR CANCELLATION OF REPRESENTATIVE

Article 16(1)(iii) of the 1999 Act
Rules 3 and 21 of the Common Regulations

Appointment, change or cancellation of representative

■ Request form:

- appoint a representative: DM/7
- change in name and/or address: DM/8
- cancel a recorded representative: DM/9
 - canceled *ex officio* where a new representative has been appointed;
 - canceled *ex officio* where a change of ownership has been recorded

■ No fee applies

Tips

- Link of request forms:

- <http://www.wipo.int/hague/en/forms/>

- Handwriting NOT allowed

- MUST signed by holder or representative recorded

- Irregularity shall be remedied within 3 months

- Change is recorded when complying with the requirements

- Fee calculator:

- <http://www.wipo.int/hague/en/fees/calculator.jsp>

- Schedule and Payment of fees:

- <http://www.wipo.int/hague/en/fees/sched.htm>



WIPO | HAGUE

The International
Design System

THANK YOU!

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